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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/740,071	12/18/2003	Warren M. Fabel	542-P0035	2138

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EXAMINER

TALBOT, MICHAEL

ART UNIT	PAPER NUMBER
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3722

MAIL DATE	DELIVERY MODE
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08/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/740,071	Applicant(s) FABEL ET AL.	
	Examiner Michael W. Talbot	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-14 in the reply filed on 04 November 2006 is acknowledged.

Specification

2. The disclosure is objected to because of the following informalities:

Refer to page 12, paragraph [0048], line 6, the second punctuation period " . " should be removed from the phrase "stored belongings. . In another embodiment" so as to read --stored belongings. In another embodiment--.

Refer to page 15, paragraph [0059], line 11, the punctuation period " . " should be removed from the phrase "removable portion 203 after it has been" so as to read --removable portion 203 after it has been--.

Appropriate correction is required.

Claim Objections

3. Claim 3 is objected to because of the following informalities:

Claim 3, line 4, the term "from" within the phrase "the mailing from can be unfolded" should be changed to --form-- so as to read --the mailing form can be unfolded--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is still unclear from Applicant's Remarks filed 04 November 2006 as to the terminology used within the specification when compared to that used in the claims. Specifically within the specification, the Applicant uses the terms "first ply" and "second ply" when referring to the multi-ply material whereas in the claims, the terminology used is "top ply" and "bottom ply". This difference in terminology makes it unclear and confusing as to particulars of the claimed limitations. Furthermore within the specification, the Applicant still refers to the individual surfaces of each ply using the terminology of "top", "back", "front", and "inside" (as these were not revised per Applicant's Remarks filed 04 November 2006), whereas in the revised claims the Applicant now refers to the individual surfaces of each ply using the terminology of "first side" or "second side" (per Applicant's amendments on page 6 of 8, 35 USC 112, 2nd paragraph, lines 5 through the end).

It appears that the Applicant inadvertently omitted revisions to the specification to ensure the consistency with the terminology now used in the amended claims. Therefore, Applicant is required to revise the specification and/or claims (if further necessary) to provide a consistent and clear set of terminology used to describe the invention.

Allowable Subject Matter

6. Claims 2-14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

7. The following is a statement of reasons for the indication of allowable subject matter:

Claims 2-14 are allowed.

Claim 2 is the sole independent claim.

Regarding claim 2, the prior art of record fails to anticipate or make obvious a mailing form comprising (1) "a first perforation along a top margin of the top ply and the bottom ply", solely or in combination, with a mailing form having a bottom ply with a first and second side, a

Art Unit: 3722

top ply with a first and a second side, wherein the second side of the top ply is located over and facing the first side of the bottom ply, an adhesive located between at least a portion of the first side of the bottom ply and at least a portion of the second side of the top ply, a removable portion of the top ply extending over the first side of the top ply, document information printed on at least a portion of the second side of the bottom ply, a vertical fold line for folding after removable portion of top ply has been removed from the bottom ply, a horizontal strip located on the first side of the bottom ply including adhesive that is exposed after the mailing form is folded along the vertical fold line, a horizontal fold line for folding after being folded along the vertical fold line wherein the adhesive of the horizontal strip secures the mailing form when folded along the horizontal fold line, and wherein the document information is firmly situated within the mailing form when the mailing form is in a completed folded configuration.

Volkert '495 is the closest art of record.

Volkert '495 discloses in Fig. 1,20-23 and in Attachment I, a form (99) comprising a bottom ply (15); an adhesive (119) interspersed between at least a portion of a first side (not shown) of the bottom ply (15) and at least a portion of a second side of the top ply (not shown); a top ply (17) located on top of the bottom ply (15); a removable portion (15a of the web shown in Fig. 20) of the top ply (15) extending over a first side (extension of web) of the top ply, such that removal exposes adhesive (on the bottom ply (17); a vertical fold line (105) securing the form when folded (see Fig. 21 and 22); a horizontal strip (121) having adhesive (119, as shown in Fig. 21 and 23) on a first side of the bottom ply (17); a horizontal fold line (103) for folding the form that has been folded along the vertical fold line (105); the adhesive (119) securing the mailing form along the horizontal fold line (see Fig. 23); wherein the information is capable of being situated within the mailing form (col. 16, lines 32-50). Furthermore, it would have been obvious to place the indicia at any desired location, since it has been held that rearranging parts

Art Unit: 3722

of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the indicia at any desired location since applicant has not disclosed the criticality of having the indicia at a particular location, and would function equally as well at any location.

Volkert '495 lacks a mailing form comprising (1) "a first perforation along a top margin of the top ply and the bottom ply".

Although it is well known to have perforation lines located on a mailing, there is no teaching in the prior art of record that would, reasonably and absent impermissible hindsight, motivate one having ordinary skill in the art to so modify the teachings of Volkert '495, noting that in Volkert '495, the top ply and bottom ply do not have any perforation lines. Furthermore, the addition of perforation lines to create a removable section located specifically at the top margin of both the top and bottom ply serves no functional purpose towards the intended use of the invention. Thus, for at least the foregoing reasons, the prior art of record neither anticipates nor rendered obvious the present invention as set forth in independent claim 2.

Conclusion

8. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

Art Unit: 3722

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MWT
Examiner
30 July 2007


MONICA CARTER
SUPERVISORY PATENT EXAMINER

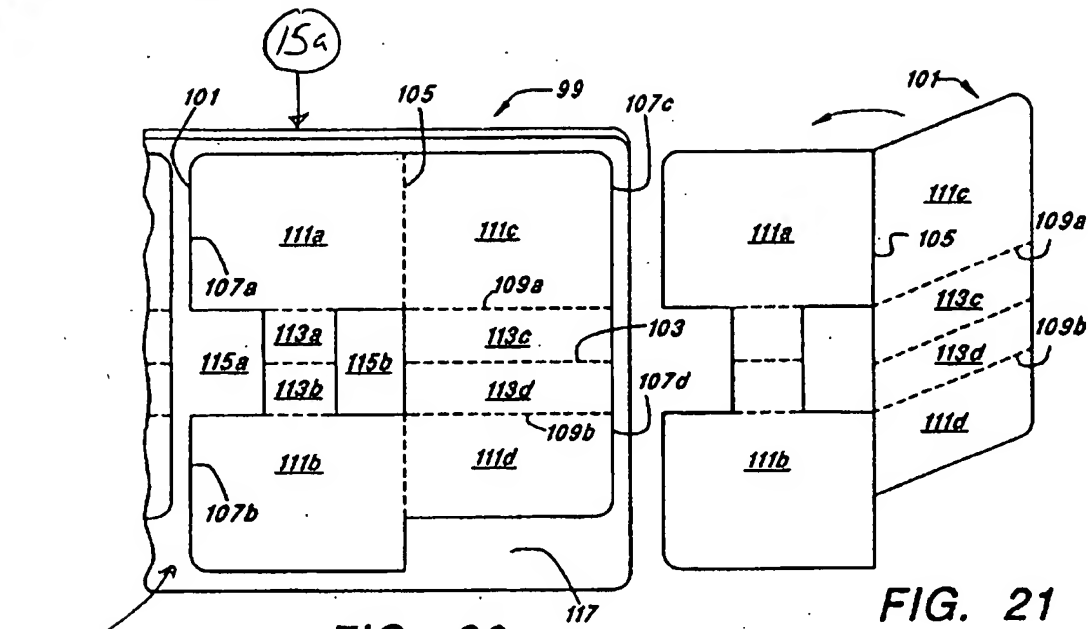


FIG. 20

FIG. 21

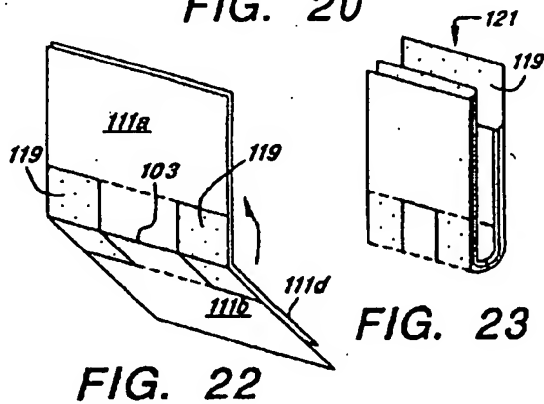


FIG. 22

FIG. 23

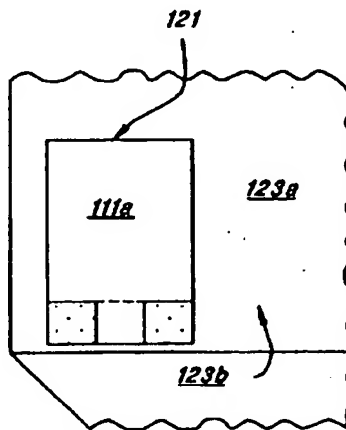


FIG. 24

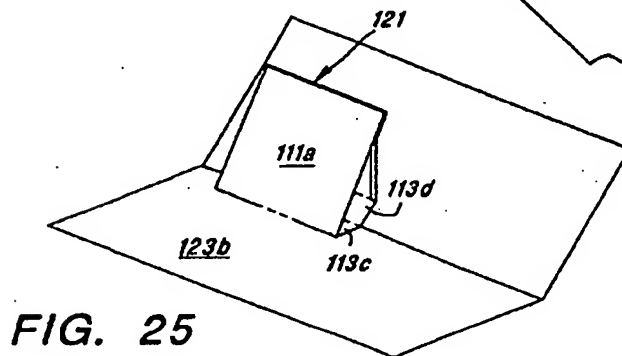


FIG. 25